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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,341	08/31/2006	Ran Oren	32176	9510
67801	7590	05/27/2009	EXAMINER	
MARTIN D. MOYNIHAN d/b/a PRTSI, INC. P.O. BOX 16446 ARLINGTON, VA 22215			MASHACK, MARK F	
ART UNIT	PAPER NUMBER			
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,341	<b>Applicant(s)</b> OREN ET AL.
	<b>Examiner</b> MARK MASHACK	<b>Art Unit</b> 3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 January 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to a communication dated 1/28/2009. Claims 1-20 are pending.

#### ***Response to Arguments***

1. Applicant's arguments filed 1/28/2009 have been fully considered but they are not persuasive. Applicant argues that **Furusawa** does not disclose "an open slot extending along the outer surface of the elongate shaft [to] the recess". Examiner disagrees. The slot extends along the shaft as clearly depicts in FIG 19. Applicant argues that **Furusawa** does not disclose that "the open slot is not formed from a first section leading from the recess towards the proximal end of the elongated shaft, and a second section leading from a juncture with the first section towards the distal end of the elongated shaft, but terminating short of the end face". Examiner disagrees. FIG 19 clearly depicts a juncture which separates two sections, the first of which leading from the recess towards the proximal end and a section leading from the juncture toward the distal end of the shaft.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

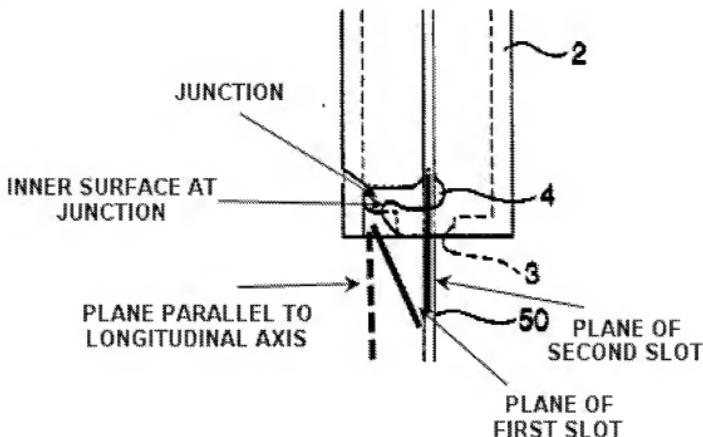
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-8** rejected under 35 U.S.C. 102(b) as being anticipated by **Furusawa** (US 2001/0041901).

**Furusawa** discloses an implement for manipulating a knotted suture comprising: an elongated shaft **2** having a proximal end and a distal end engageable with a knotted suture (FIG 19); a distal end with a recess **3** for receiving the knot of the suture; said distal end has an open slot **4, 5** with a first section leading from said recess towards the proximal end and a second section leading from a juncture with said first section towards the distal end but terminating short of the end face. Said first slot section is a three dimensional object and hence has an infinite amount of plane, one of which is in a plane at an angle of 10-30 degrees relative to the longitudinal axis. Said second slot section additionally comprises a plane parallel to the longitudinal axis of the elongated shaft (FIG 19C). The second slot section can be considered leading towards the distal end but terminating short since it widens towards the distal end after the inner surface of the junction. One segment of the plane of said second slot section is rotated approximately 90 degrees with respect to one segment of the plane of said first slot section (FIG 19A). The slots decrease from said juncture toward the distal since the rounded inner surface of the junction juts out into the slots.

Fig. 19C



***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Andreas et al. (US 5,797,929)**.

**Furusawa** discloses all of the claimed limitations except for the distal end of the elongated shaft being formed with an increased outer diameter with the slot extending through said distal end. However, **Andreas** discloses a similar implement **18** comprising an enlarged distal end **22** (FIG 3-4). All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Andreas**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** with an enlarged distal end in order to facilitate capture and retention of the suture (Column 6, Lines 3-6).

7. **Claims 10, 13-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Pierce (US 5,176,691)**.

**Furusawa** discloses all of the claimed limitations as stated above concerning the implement but does not explicitly disclose the tubular cutter with an annular cutting edge. However, **Pierce** discloses a similar implement **12** for surgically manipulating a knotted suture **10** comprising a tubular cutter **124** with a cutting edge (FIG 15 and Column 6, Lines 38-45). All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Pierce**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** with a tubular cutter with a cutting edge. Doing so would facilitate the cutting of the suture especially in hard to reach places.

8. **Claim 11-12 and 20** rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Pierce** as applied to **claim 10 and 13** above, and further in view of **Dana et al. (US 2003/0109891)**.

**Furusawa** in view of **Pierce** disclose all of the claimed limitations as stated above except for the releasable latch for retaining said elongated shaft projecting distally from the tubular cutting member or the pivoting handles members to permit manipulating relative movement between the implement and the cutting member. However, **Dana** discloses a similar implement with a cutting member **60** and a cutting

member actuating device **40** which is biased in the retracted stage and advances the cutting member **60** to sever the suture. The cutting member actuating device **40** is actuated by pivoting relative to the housing **30** in order to advance the cutting member relative to the elongated member **50**. Therefore the cutting member actuating device **40** can be considered a latch that retains the elongated shaft **50** in an initial position wherein the distal end projects from the distal end of the tubular cutting member **60**. Additionally cutting member actuating device can also be considered a handle member which pivots relative to the housing which is the other handle member in order to manipulate relative movement between the elongated shaft and the cutting member. All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Dana**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** in view of **Pierce** with a cutting member actuating device. Doing so would facilitate the cutting of the excess suture proximal to the knot.

9. **Claim 18-19** rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Pierce** as applied to claim 17 above, and further in view of **Andreas**.

**Furusawa** in view of **Pierce** discloses all of the claimed limitations except for the distal end of the elongated shaft being formed with an increased outer diameter with the slot extending through said distal end. However, **Andreas** discloses a similar implement **18** comprising an enlarged distal end **22** (FIG 3-4). Said enlarged distal end **22** can be considered a “finger-piece” to facilitate handling of the distal end. All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Andreas**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** with an enlarged distal end in order to facilitate capture and retention of the suture (Column 6, Lines 3-6).

#### *Conclusion*

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK MASHACK whose telephone number is (571)270-3861. The examiner can normally be reached on Monday-Thursday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Mashack/  
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/  
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